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OFFICE OF PETITIONS

In re Application	:
Burger et al.	:
Application No. 09/667,556	: DECISION ON APPLICATION
Filed: September 22, 2000	: FOR PATENT TERM ADJUSTMENT
Atty Docket No. 037067-0114	:

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(b)," filed May 17, 2004. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from zero (0) days to one hundred eleven (111) days.

For the reasons set forth below, a decision on the request for reconsideration of the patent term adjustment indicated on the patent application is being **HELD IN ABEYANCE** until issuance of the patent.

Applicants are given two months from the issue date of the patent to request reconsideration of the patent term adjustment indicated on the patent application. Applicants may seek such reconsideration without payment of the fee. A copy of this decision should accompany applicants' written request for reconsideration.

On February 17, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is zero (0) days. On May 17, 2004, applicants timely¹ submitted an application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is one hundred eleven (111) days.

Applicants specifically state that the patent issuing from the application is not subject to a terminal disclaimer.

The Office initially determined a patent term adjustment of zero (0) days based on the following. The above-identified application was filed on September 22, 2000. The PTO timely mailed a first office action within 14 months, pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1), on April 18, 2001. Applicants did not respond until August 20, 2001. As this response was not within the three month time period pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. § 1.704(b), applicant delay of thirty-three (33) days was assessed. Next, applicants filed a supplemental paper, an IDS, on October 26, 2001, incurring additional applicant delay of sixty-seven (67) days pursuant to 35 U.S.C. 154(b)(2)(C)(i) and 37 C.F.R. § 1.704(c)(8).

Next, the PTO timely mailed an Office action within 4 months, pursuant to U.S.C. 154(b)(1)(A)(ii) and 37 C.F.R. § 1.703(a)(2), on November 6, 2001. Applicants did not reply until May 6, 2002. Although this reply was made timely for the purpose of avoiding abandonment by obtaining a three month extension of time, the reply was not timely for the purpose of PTA.² Accordingly, applicant delay of eighty-nine (89) days was properly assessed.

The PTO then timely mailed an Office action on July 16, 2002, to which applicants timely replied on August 14, 2002. However, applicants incurred additional delay by filing an IDS on September 18, 2002 and March 28, 2003. The delay begins "on the day after the date the initial reply was filed and ending on the

¹ PALM records indicate that applicant paid the issue fee together with the application for patent term adjustment on May 17, 2004.

² See Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term, 1239 O.G. 14 (Oct. 3, 2000).

date that the supplemental reply or other such paper was filed."³ Accordingly, applicant delay of two hundred twenty-six days (226) should have been assessed for the filing of the IDS on March 28, 2003.

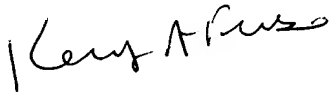
Lastly, the PTO should have been assessed delay of two hundred ninety-two (292) days for the mailing of a final Office action on October 2, 2003, in response to applicants' amendment filed August 14, 2002.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **zero (0) days** (292 days of PTO delay, reduced by 415 (33 + 67 + 89 + 226) days of applicant delay).

Receipt of the \$200.00 fee set forth in 37 C.F.R. §1.18(e) is acknowledged.

The application file is being forwarded to the Office of Patent Publication for processing into a patent.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (703) 305-0272.



Karin Ferriter
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Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

³ 37 C.F.R. §1.704(c)(8).